

REMARKS

Claims 10-17 remain in this application.

The Office Action maintains the rejections based on 35 USC 101, 35 USC §112 ¶1 and 35 USC §112 ¶2. However, the Office Action includes no responses to applicant's arguments opposing these rejections. As such, the applicant requests that the examiner address the applicant's arguments and provide the applicant an additional opportunity to respond. ✓

The Office Action includes a new claim rejection under 35 USC §103(a) with regard to claim 12. According to the action, claim 12 is unpatentable over Galbo in view of Harris. The Office Action admits that Galbo doesn't explicitly recite "providing a gas cap cover device on the replacement gas cap..." but that it would have been obvious to do so because:

- "selection of such features would have provided 'a mechanism with the cap to deliver a reminder message to a person removing the cap from the filler tube...' (citing Galbo column 2, lines 1-7); and because

- such selection would have provided means 'to seal properly the fuel tank filler necks of vehicles so that, for environmental reasons, fuel vapors are prevented from leaking into the atmosphere...' (citing Harris column 1, lines 16-20)."

In response, the applicant maintains that claim 12 is patentable over Galbo in view of Harris because neither Galbo nor Harris disclose a method that includes the step of providing a gas cap cover device on a replacement gas cap. Neither does either Galbo or Harris disclose providing such a cover device bearing a message. Neither does either reference disclose providing a cover device that includes a shell configured to be disposed over a portion of a gas cap. Neither does either reference disclose providing a cover device that includes a connector supported on a shell and configured to engage a gas cap and cause the gas cap to rotate when the cover device is rotated. Because neither

Galbo nor Harris discloses any of the above limitations, a combination of those references cannot reach the invention of claim 12.

In addition, even if Galbo and Harris did disclose all the limitations of claim 12, the Action doesn't identify a teaching, suggestion, or motivation to combine them in such a way as to arrive at the invention of claim 12. The passage that the Office Action quotes from Galbo (column 2, lines 1-7) as providing a motivation to modify the Galbo method to include the step recited in claim 12 is merely an advantage that might be realized by that modification. The applicant maintains that the examiner's ability to identify an advantage that such a modification would realize is not part of the judiciously defined obviousness inquiry. If it were, then almost all claimed combinations would be obvious and unpatentable. The PTO could routinely identify claimed elements in the prior art, observe that there was an advantage in combining them as the applicant has claimed, and simply reject the claims on that basis. Under this rule the existence of an advantage would almost always prevent inventions from being patented (and would arguably render most issued patents invalid).

Although motivation need not be found by identifying an explicit teaching or suggestion in all cases, it's not enough to simply identify an advantage (especially, where as here, the examiner has not identified in the prior art of record, or in knowledge generally available to those skilled in the art, the feature or step that provides the advantage). The examiner must show that there is at least some implicit teaching or suggestion in the prior art or general knowledge that would have motivated one skilled in the art to combine the references. *In re Oetiker*, 24 USPQ 2nd, 1443, 1446-1447 (Fed. Cir. 1992). To show that there's an implicit suggestion, an examiner must show that one skilled in the art would know to use a prior art teaching to solve the problem that the applicant sought to solve through the invention in question. *Id.* For this to be the case, the problem that the invention solves must be the same as or at least similar to the problem that the prior art teaching solves. It's not sufficient to merely identify an advantage that the combination would realize.

Still further, in supporting the obviousness rejection of claim 12, the Office Action cites a passage from Harris (column 1, lines 16-20). It's unclear to the applicant how the cited passage relates to the step that claim 12 recites. The cited passage relates to the proper sealing of fuel tank filler necks in vehicles. Claim 12 recites the addition of a gas cap cover device that has no effect on the ability of a host gas cap to seal a fuel tank. The applicant asks that the examiner explain how the cited passage relates the limitations recited in claim 12.

For the above reasons the applicant maintains that claim 12 is patentable over Galbo in view of Harris.

The Office Action maintains its rejections of claims 10, 11 and 13-17 under 35 USC 103(a) as being unpatentable over Galbo in view of Harris.

In response to the applicant's argument opposing the rejection of claim 10, the Office Action defends its use of hindsight reasoning as being of a permissible form of hindsight reasoning that takes into account only knowledge that was within the level of ordinary skill at the time the claimed invention was made and did not include knowledge gleaned only from the applicant's disclosure. The action then cites several Federal Circuit opinions that set forth guidelines for determining whether or not there is a suggestion or motivation to combine teachings from different references in an obviousness determination. The action then claims to have met all the requirements that the Federal Circuit laid out in those opinions because the action quoted from the references "cogent reasons (i.e. motivation) to combine and/or modifying the teachings." However, the test of an implicit motivation or suggestion to combine is whether one skilled in the art would know to use an existing teaching to solve another problem that's the same as or similar to the problem that the teaching suggests. See e.g. *In re Oetiker*, 24 USPQ 2nd, 1443, 1446-1447 (Fed. Cir. 1992). In other words, when there is no explicit suggestion to combine, to show that there's an implicit suggestion, the examiner must show that one skilled in the art would know to use a prior art teaching (from the prior art of record or knowledge generally available to those skilled in the art), to solve

the problem that the applicant seeks to solve through the invention in question. For this to be the case, the problem that the invention solves must be the same as or similar to the problem that the prior art teaching solves. *Id.* The action has not provided such an analysis.

The action also indicates that it relied on “knowledge generally available to one of ordinary skill in the art” as a source of motivation and asserts that the teachings of the references combined with the knowledge of one of ordinary skill in the art either teaches or suggests all the elements and limitations of the invention. However, while stating that the action relies on knowledge generally available to one of ordinary skill in the art, the action does not identify what knowledge the action is referring to. If the action does not identify what prior art teaching (drawn from knowledge generally available to those skilled in the art) that the action is relying on, the applicant is unable to assess whether that teaching satisfies the *In re* Oetiker implicit suggestion test set forth above.

As such, the applicant requests that the examiner identify what specific teachings the examiner has drawn from knowledge generally available to one of ordinary skill in the art. The applicant traverses the examiner’s assertion of reliance upon knowledge generally available to one of ordinary skill in the art because the examiner has not identified what those teachings are. The applicant requests that the examiner identify those teachings and provide documentary evidence in the next Office Action if the rejection is to be maintained. The applicant also requests that the examiner explain what problem those teachings (drawn from knowledge generally available to one of ordinary skill in the art) solve that is the same or at least similar to the problem that the claimed invention solves.

With regard to claims 13-17 the Action only indicates that the applicant has failed to present an appropriate challenge to the taking of official/judicial notice because the applicant’s arguments didn’t include a specific per se demand for references. In response, the applicant traverses the examiner’s assertion of official notice and asks that the examiner provide documentary evidence in the next Office Action to support each

such assertion of official/judicial notice and reliance on teachings drawn from generally available knowledge.

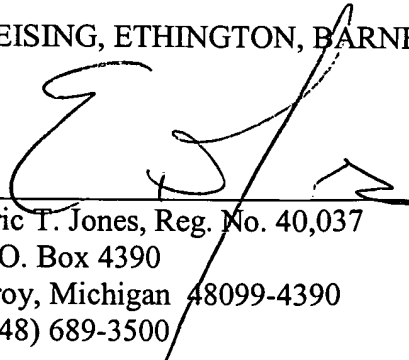
In addition, with regard to claims 13-17, the applicant requests that the examiner identify each fact that the examiner is officially taking notice of. The applicant also requests that, where there is no explicit motivation to combine those features to arrive at any of the inventions recited in the pending claims, the examiner identify what problem the prior art teaching solves that is the same or similar to the problem that the invention solves so that the applicant will have an adequate opportunity to evaluate the examiner's reasoning and prepare a response.

Claims 10-17 recite patentable subject matter and are allowable. Therefore, the applicant respectfully submits that the application is in condition for allowance and respectfully solicits such allowance. Please favorably reconsider the outstanding Office Action.

The Commissioner is authorized to charge any deficiencies, or credit any overpayment, in connection with this communication to Deposit Account No. 50-0852. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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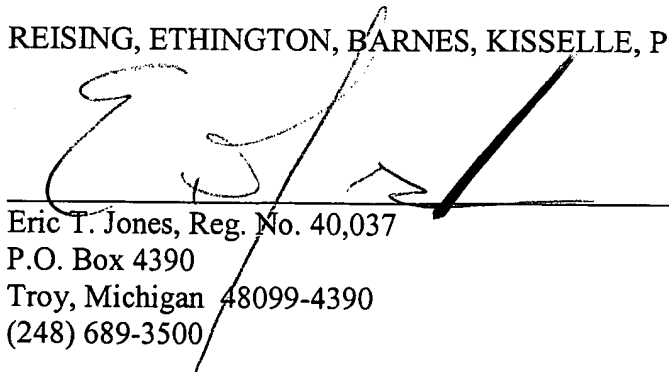
In addition, with regard to claims 13-17, the applicant requests that the examiner identify each fact that the examiner is officially taking notice of. The applicant also requests that, where there is no explicit motivation to combine those features to arrive at any of the inventions recited in the pending claims, the examiner identify what problem the prior art teaching solves that is the same or similar to the problem that the invention solves so that the applicant will have an adequate opportunity to evaluate the examiner's reasoning and prepare a response.

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